

**REMARKS:**

Claims 2, 4-30, and 32-45 are currently pending in the application. Claims 2, 4-30, and 32-45 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,787,000 to Lilly et al. ("Lilly") in view of U.S. Patent No. 5,548,518 to Dietrich et al. ("Dietrich") and in further view of U.S. Patent No. 5,111,391 to Fields et al. ("Fields").

By this Amendment, independent claims 2 and 32, and dependent claims 17 and 45 have been amended to more particularly point out and distinctly claim the Applicants invention. In addition, dependent claim 9 has been amended to correct certain dependencies. By making these amendments, the Applicants makes no admission concerning the merits of the Examiner's rejection, and respectfully deny any statement or averment of the Examiner not specifically addressed. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent Application of substantially the same scope of originally filed claims 1-27. No new matter has been added.

**CLAIM OBJECTIONS:**

The Applicants thank the Examiner for withdrawing the objection to claims 2, 4-7, 12, 18-20, 25, 32-35, and 40. In withdrawing the objection, the Examiner acknowledges, and the Applicants agree, that Lilly and Dietrich fail to teach each and every feature of the claimed invention. Specifically the Examiner acknowledges that Lilly and Dietrich do not teach the required resources having an ability level and each task specifying a minimum ability level of one or more resources to be used for that task. (18 August 2005 Office Action, Page 2).

## **REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 2, 4-30, and 32-45 stand rejected under 35 U.S.C. § 103(a) over Lilly in view of Dietrich and in further view of Fields.

Although the Applicants believe claims 2, 4-30, and 32-45 are directed to patentable subject matter without amendment, the Applicants have amended independent claims 2 and 32 and dependent claims 17 and 45 to more particularly point out and distinctly claim the Applicants invention. In addition, dependent claim 9 has been amended to correct certain dependencies. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that Lilly, Dietrich, or Fields either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2, 4-30, and 32-45. Thus, the Applicants respectfully traverse the Examiners obvious rejection of claims 2, 4-30, and 32-45 under 35 U.S.C. § 103(a) over the proposed combination of Lilly, Dietrich, or Fields, either individually or in combination.

### **The Proposed Lilly-Dietrich Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

For example, with respect to amended independent claim 2, this claim recites:

A method for scheduling development planning for a plurality of products of an enterprise, comprising:

receiving a list of a plurality of products to be developed;

receiving a list of required completion dates, each completion date specifying the completion date for the development of a corresponding product in the plurality of products;

receiving, for each product in the plurality of products, a project definition of a project for developing the product, each project definition defining:

a plurality of tasks required to complete a project for developing the product associated with the project definition; and

a list of resources required to complete each task defined in the product definition, at least one of the plurality of tasks for at least one of the plurality of projects requiring a material to be provided by an outside party distinct from the enterprise;

receiving a list of available resources, each resource in the list of available resources is assigned an ability level and having a capacity as a function of time;

receiving, for each task requiring a resource, a specified minimum ability level of one or more resources to be used for that task;

receiving a list of materials available from outside parties distinct from the enterprise and a schedule of availability of the materials available from the outside parties; and

maintaining a scheduler operable to automatically generate a development schedule comprising all tasks for all projects, the development schedule allocating the resources such that each resource is allocated at a level less than or equal to its capacity, the development schedule also allocating the resources that have an ability level at least as high as the specified minimum ability level, the development schedule also scheduling tasks that require materials from outside parties at a time when such materials will be available. (Emphasis Added).

Independent claim 4 and amended independent claim 32 recite similar limitations. Lilly, Dietrich, and Fields, either individually or in combination, fail to disclose each and every limitation of independent claims 2, 4, and 32.

The Applicants have reviewed Lilly in detail, particularly looking for a system for scheduling development planning, relied upon by the Examiner. (18 August 2005 Office Action, Pages 2-3). However, Lilly fails to disclose, teach or suggest several of the limitations recited by amended independent claim 2. Thus, the Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in Lilly.

The Applicants respectfully submit that Lilly has nothing to do with amended independent claim 2 limitations regarding scheduling development planning for a plurality of products of an enterprise. Rather Lilly discloses a system for scheduling work orders in a manufacturing process. (Abstract). The work order scheduling of Lilly merely provides for a computerized schedule of specified operations to be performed in a manufacturing process. Lilly does not disclose, teach, or suggest assigning an ability level associated with the list of available resources, in the development planning of the schedule or even in

the work order scheduling. In addition, Lilly does not disclose, teach or suggest a specified minimum ability level of one or more resources to be used for each task requiring a resource. In fact, the Office Action acknowledges, and the Applicants agree, that Lilly does not teach the required resources having an ability level and each task specifying a minimum ability level of one or more resources to be used for that task. (18 August 2005 Office Action, Page 2).

The Applicants further submit that the Office Action acknowledges, and the Applicants agree, that Lilly fails to disclose the emphasized limitations noted above in amended independent claim 2. Specifically the Examiner acknowledges that Lilly does not teach: (1) receiving a list of materials available from outside parties distinct from the enterprise and a schedule of availability of the materials available from the outside parties and (2) the development schedule also scheduling tasks that require materials from outside parties at a time when such materials will be available. (18 August 2005 Office Action, Page 4). However, the Examiner asserts that the cited portions of Dietrich disclose the acknowledged shortcomings in Lilly.

The Applicants have reviewed Dietrich in detail, particularly looking for the scheduling system, relied upon by the Examiner. (18 August 2005 Office Action, Page 4). However, Dietrich fails to disclose, teach or suggest several of the limitations recited by amended independent claim 2. Thus, the Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in Dietrich.

The Applicants respectfully submit that Dietrich has nothing to do with amended independent claim 2 limitations regarding scheduling development planning for a plurality of products of an enterprise and in particular Dietrich has nothing to do with amended independent claim 2 limitations regarding receiving a list of materials available from outside parties distinct from the enterprise and a schedule of availability of the materials available from the outside parties. Rather Dietrich discloses a system that correlates sufficient capacity or material availability to meet requirements. (Column 4, Lines 40-45). Dietrich merely discloses a comparison of the requirements through production and if these requirements are met, then the external availability schedule corresponds to the

requirements. Dietrich does not disclose, teach, or suggest receiving a list of materials available from outside parties that are distinct from the enterprise and a schedule of availability, or even an external availability schedule, of the materials available from the outside parties that are distinct from the enterprise.

The Applicants further submit that the Office Action acknowledges, and the Applicants agree, that the combination of Lilly and Dietrich do not teach each and every feature of the claimed invention. Specifically the Examiner acknowledges that the Lilly and Dietrich combination does not teach the required resources having an ability level and each task specifying a minimum ability level of one or more resources to be used for that task. (18 August 2005 Office Action, Page 2).

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Lilly and Dietrich, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine Lilly and Dietrich as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art at the time the invention to incorporate Dietrich's external availability schedule for materials into Lilly's scheduling system to account for all materials available to generate a specific product. (18 August 2005 Office Action, Page 4). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in Lilly or Dietrich, either individually or in combination. The Examiner asserts that one of ordinary skill in the art, at the time of the invention, would have been motivated to modify Lilly and Dietrich to increase the efficiency of the scheduling system. (18 August 2005 Office Action, Page 4). The Applicants respectfully disagree. The Applicants respectfully request the Examiner to point to the portions of Lilly or Dietrich which contain the teaching, suggestion, or motivation to combine Lilly or Dietrich for the Examiners stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template

to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Lilly and Dietrich to render obvious the Applicants claimed invention. The Examiner's conclusory statements that it would have been obvious "to incorporate Dietrich's external availability schedule for materials into Lilly's scheduling system to account for all materials available to generate a specific product" and that "thereby increasing the efficiency of the scheduling system" does not adequately address the issue of motivation to combine. (18 August 2005 Office Action, Page 4). This factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of Lilly or Dietrich, either individually or in combination.

### **The Proposed Lilly-Dietrich-Fields Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that Lilly and Dietrich fail to disclose the emphasized limitations in amended independent claim 2. Specifically the Examiner acknowledges that the Lilly and Dietrich combination fails to disclose the required resources having an ability level and each task specifying a minimum ability level of one or more resources to be used for that

task. (18 August 2005 Office Action, Pages 2 and 4). However, the Examiner submits a general assertion that Fields discloses the acknowledged shortcomings in Lilly and Dietrich, without citing any specific portion of Fields.

The Applicants have reviewed Fields in detail, particularly looking for a system for scheduling development planning, relied upon by the Examiner. (18 August 2005 Office Action, Pages 4-5). However, Fields fails to disclose, teach or suggest several of the limitations recited by amended independent claim 2. Thus, the Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in Fields.

The Applicants respectfully submit that Fields has nothing to do with amended independent claim 2 limitations regarding scheduling development planning for a plurality of products of an enterprise and in particular Fields has nothing to do with amended independent claim 2 limitations regarding maintaining a scheduler operable to automatically generate a development schedule comprising all tasks for all projects, the development schedule allocating the resources such that each resource is allocated at a level less than or equal to its capacity, the development schedule also allocating the resources that have an ability level at least as high as the specified minimum ability level, the development schedule also scheduling tasks that require materials from outside parties at a time when such materials will be available. Rather Fields discloses a staff scheduling data processing system. (Abstract). This system in Fields is merely a database for storing and retrieving information associated with staff and management personal. Fields does not disclose, teach, or suggest scheduling development planning for a plurality of products of an enterprise or maintaining a scheduler operable to automatically generate a development schedule comprising all tasks for all projects, the development schedule allocating the resources such that each resource is allocated at a level less than or equal to its capacity, the development schedule also allocating the resources that have an ability level at least as high as the specified minimum ability level, the development schedule also scheduling tasks that require materials from outside parties at a time when such materials will be available.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Lilly, Dietrich, and Fields, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine Lilly, Dietrich, and Fields as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art to include Fields specification of a skill level for each task and subsequent skill levels of resources in order to more efficiently allocate each resource to a task. (18 August 2005 Office Action, Page 5). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in Lilly, Dietrich, and Fields, either individually or in combination. The Examiner asserts that one of ordinary skill in the art, at the time of the invention, would have been motivated to modify Lilly and Dietrich to ensure the highest quality products. (18 August 2005 Office Action, Page 5). The Applicants respectfully disagree. The Applicants respectfully request the Examiner to point to the portions of Lilly, Dietrich, or Fields which contain the teaching, suggestion, or motivation to combine Lilly, Dietrich, or Fields for the Examiners stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Lilly, Dietrich, or Fields, either individually or in combination.



A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Lilly, Dietrich, and Fields to render obvious the Applicant's claimed invention. The Examiner's conclusory statements that it would have been obvious "to include Fields specification of a skill level for each task and subsequent skill levels of resources in order to more efficiently allocate each resource to a task " and that "by allocating based on required skill level, each task would be completed by the most qualified resource thereby ensuring highest quality products" does not adequately address the issue of motivation to combine. (18 August 2005 Office Action, Page 5). This factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of Lilly, Dietrich, or Fields, either individually or in combination.

### **The Proposed Lilly-Examiner's-Official-Notice Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

The Applicants respectfully submit that Lilly or the Examiner's Official Notice, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent claims 17, 30, and 45. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of dependent claims 17, 30, and 45 under 35 U.S.C. § 103(a) over the proposed combination of Lilly and the Examiner's Official Notice, either individually or in combination.

For example, with respect to amended dependent claim 17, this claim recites:

17. The method of Claim 2, wherein the scheduler is operable to automatically generate the development schedule using a genetic algorithm. (Emphasis Added).

Dependent claim 30 and amended dependent claim 45 recites similar limitations. Lilly or the Examiner's Official Notice, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 17, 30, and 45.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that Lilly fails to disclose the emphasized limitations noted above in amended dependent claim 17. Specifically the Examiner acknowledges that Lilly fails to teach a scheduler operable to automatically generate the development schedule using a generic algorithm. (18 August 2005 Office Action, Pages 9-10). However, the Examiner asserts Official Notice over the acknowledged shortcomings in Lilly. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in the Examiner's Official Notice.

The Applicants further submit that the Applicants are confused as to what the Examiner teaches by the Official Notice or even the extent in which the Examiner is taking Official Notice. The Applicants respectfully request clarification as to the subject matter for which the Examiner is taking Official Notice. The Applicants respectfully traverse the Official Notice because the asserted facts, as best understood by the Applicants, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). The Applicants respectfully request the Examiner to produce authority for the Examiner's Official Notice.

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection".

(MPEP § 2144.03). “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy the dispute’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).” (MPEP § 2144.03(A)). (Emphasis Added).

“It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)).

“Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

The Applicants respectfully submit that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of "instant and unquestionable" demonstration as being well-known. The Applicants further submit that the Applicants have adequately traversed the Examiner's assertion of Official Notice and direct the Examiner's attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of claims 17, 30, and 45 based on the Examiner's Official Notice, the Applicants respectfully request that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Applicants further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

In addition, the Applicants respectfully point the Examiner to the pertinent sections of the MPEP, directly on point to determine whether the next Office Action should be made Final. In particular, the Applicants respectfully direct the Examiner's attention to MPEP § 2144.03(D), which states:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the

rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. (MPEP § 2144.03(D)).

The Applicants further submit that the Examiner asserts:

However, it is old and well known to use genetic algorithms to solve scheduling problems since genetic algorithms are useful in maximizing or minimizing an objective function within a set of constraints, thereby increasing the efficiency of the scheduling system. (18 August 2005 Office Action, Pages 9-10).

The Applicants respectfully disagree. This purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in Lilly. The Applicants respectfully request the Examiner to point to the portions of Lilly which contain the teaching, suggestion, or motivation to combine Lilly with the Examiners Official Notice for the Examiners stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Lilly and the Examiners Official Notice, either individually or in combination.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added).

Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Lilly and the Examiners Official Notice to render obvious the Applicant's claimed invention. The Examiner's conclusory statement that "it is old and well known to use genetic algorithms to solve scheduling problems" does not adequately address the issue of motivation to combine. (18 August 2005 Office Action, Page 9). This factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of Lilly and the Examiners Official Notice, either individually or in combination.

### **The Proposed Lilly-Dietrich-Fields Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

The Applicants respectfully submit that independent claims 2, 4, and 32 are considered patentably distinguishable over the proposed combination of Lilly, Dietrich, and Fields. Lilly, Dietrich, and Fields do not disclose, suggest or even hint at the unique and novel limitations disclosed in now independent claims 2, 4, and 32. This being the case, independent claims 2, 4, and 32 are considered patentably distinguishable over the proposed combination of Lilly, Dietrich, and Fields.

With respect to dependent claims 5-30 and 33-45: claims 5-17 depend from amended independent claim 2; claims 18-30 depend from independent claim 4; and claims 33-45 depend from amended independent claim 32. As mentioned above, each of independent claims 2, 4, and 32 are considered patentably distinguishable over the proposed combination of Lilly, Dietrich, and Fields. Thus, dependent claims 5-30 and 33-45 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicants submit that claims 2, 4-30 and 32-45 are not rendered obvious by the proposed combination of Lilly, Dietrich, and Fields. The Applicants further submit that claims 2, 4-30 and 32-45 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 2, 4-30 and 32-45 under 35 U.S.C. § 103(a) be reconsidered and that claims 2, 4-30 and 32-45 be allowed.

### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one

of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.



**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

11/2/05  
Date



James E. Walton, Registration No. 47,245  
Brian E. Harris, Registration No. 48,383  
Steven J. Laureanti, Registration No. 50,274  
Daren C. Davis, Registration No. 38,425  
Michael Alford, Registration No. 48,707  
Law Offices of James E. Walton, P.L.L.C.  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955 (voice)  
(817) 447-9954 (facsimile)  
jim@waltonpllc.com (e-mail)

**CUSTOMER NO. 53184**  
**ATTORNEYS AND AGENTS FOR APPLICANTS**